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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,457	06/28/2001	Kenichi Samoshima	010825	2154

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EXAMINER

SHOSH, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/892,457

Applicant(s)

SAMESHIMA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-2 and 4-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 10/31/03 has been fully considered. However, the amendment has not been entered given that it raises new issues under 35 USC 112, first paragraph and second paragraph.

Specifically, applicants have amended claim 1 to recite that "the resol resin composition does not contain AlCl_3 ". It is the examiner's position that such recitation raises new issues under 35 USC 112, first paragraph since the cite phrase clearly signifies a "negative" or "exclusionary" limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

As support for the recitation of the phrase "the resol resin composition does not contain AlCl_3 " applicants point to page 7, lines 7-10 of the present specification which states that the resin composition is obtained by only mixing three components (A), (B), and (C). However, it is noted that this disclosure does not support the specific exclusion of AlCl_3 from the present claims. In *Grasselli*, the courts upheld that "the express exclusion of certain elements not discussed in the original specification together with the implicit inclusion of all other elements not originally in the original specification constitutes new matter, i.e. lacks description in the original specification and violates the provisions of the first paragraph of 35 U.S.C. 112." Thus, the inclusion of the phrase "the resol resin composition does not contain AlCl_3 " implicitly includes all other elements not explicitly excluded by this phrase for which there is also no support in the specification. Further, it is noted that while the present specification is silent with

respect to the use of AlCl_3 , is noted that as stated in MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion.”

Additionally, applicants have amended claim 1 and claim 5 to each recite “resol-type phenol resin”. It is the examiner’s position that such amendment raises new issues under 35 USC 112, second paragraph. As set forth in paragraph 2 of the office action mailed 11/6/02, such amendment makes the scope of the claims confusing because it is not clear what is meant by “type”. What resins are encompassed by this phrase? The addition of the word “type” extends the scope of the claims so as to render them indefinite since it is unclear what “type” is intended to convey. The addition of the word “type” to the otherwise definite expression renders the definite expression indefinite by extending its scope. *Ex parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955).

Further, it is noted that even if the amendment filed 10/31/03 was entered, the present claims would not be allowable over the cited prior art of record for the following reasons.

With respect to Gerber et al. (U.S. 5,294,649), applicants argue that while Gerber disclose accelerator comprising anion and cation, thiosulfate is but one of 13 anions disclosed by Gerber et al. while ammonium is but one of a large list of cations disclosed by Gerber et al. Further, applicants note that Gerber et al. specifically recites 9 salts but does not include ammonium thiosulfate as presently claimed.

However, as set forth in MPEP 2131.02, when a compound is not specifically named, but it is necessary to select portions of teachings within a reference and combine them, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated, *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able

to “at once envisage” the specific compound within the generic claimed formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be “at once envisaged”.

This portion of the MPEP is directly applicable to the rejection of record with respect to Gerber et al. Given that Gerber et al. disclose small number of anions, i.e. 13, and cations, i.e. 8, and given that one of ordinary skill in the art would be able to write the name of each of the accelerators disclosed by Gerber et al., it is clear that one of ordinary skill in the art would be able to “at once envisage” the specific accelerator presently claimed, namely, ammonium thiosulfate.

Thus, it is the examiner’s position that the claims are properly anticipated with respect to Gerber et al.

With respect to Meyer, applicants argue that there is no motivation to combine Cooper with Meyer given that Meyer only discloses the use of ammonium thiosulfate with urea formaldehyde not with resol-type phenol resin as presently claimed.

While Meyer does disclose the use of ammonium thiosulfate with urea formaldehyde in example 7, this is only one preferred embodiment of Meyer. It is noted that, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair

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reading of the reference as a whole discloses that Meyer teaches the use of sulfur containing compound including ammonium thiosulfate with formaldehyde containing resins wherein the formaldehyde containing resins include not only urea formaldehyde but also phenol formaldehyde as presently claimed.

Thus, it is the examiner's position that the combination of Cooper with Meyer is proper.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
11/20/03